

Remarks

Claims 1-42 were pending in the application. Claims 1-7, 17-24, 26-32, and 37-42 were rejected. Claims 8-16, 25, and 33-36 were previously withdrawn. No claims were merely objected to and no claims were allowed.

Claim Rejections-35 U.S.C. 112

Claims 37-40 were previously rejected under 35 U.S.C. 112(1). In a new ground of rejection, claims 41 and 42 were rejected under 35 U.S.C. 112(1). Applicants respectfully traverse the rejections.

The Office asserts:

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

8/10/09 Examiner's Answer, page 3, lines 15-18. First, the Office has failed to make appropriate findings and provide a reasoned explanation regarding the nature of one skilled in the art (e.g., the level of skill including education and experience and access to resources). Then, the Office has failed to properly apply that level of skill to the prior art and the asserted non-enabled subject matter (see discussion below).

The Office then asserted:

These claims recite a "system control box". The specification fails to clearly describe the function of this system control box. The specification merely states that "commands issued by processor 14 can be enacted on the compressor" (page 6, para. 1). However, it is not at all clear in what manner the commands are enacted and/or processed. This would impose an undue burden on one of ordinary skill in the art to make and use the invention.

8/10/2009 Examiner's Answer, page 3, last four lines-page 4, line 2. This raises several further issues.

The present invention is drawn to a compressor protection module which obtains and analyzes input from the compressor and uses that input to select certain control commands to be issued to the compressor. The system control box is described in the specification, for example at page 6, lines 3-7. There, it is disclosed that:

Still referring to Figure 1, module 12 may advantageously be communicated with a system control box 40 such that commands issued by processor 14 can be enacted on the compressor, for example to change operating speed, turn off

power, control crankcase heater operation, and the like.

Page 6, lines 3-7. In light of this, it is clear that nothing more is needed in the disclosure. The invention does not relate to the type of specific details that are found missing by the Examiner. The current inventors do not claim to have invented a specific manner in which commands are enacted or processed, and it is submitted that the present disclosure, showing a control box connected with the processor and various inputs and outputs, would certainly enable a person skilled in the art to make and use the invention including the system control box. One skilled in the art would have sufficient experience to program/configure the module 12 and system control box 40.

Furthermore, the enablement rejection runs directly contrary to the Office's on-art rejections. This, again, highlights the failure of the Office to engage in appropriate background fact finding (e.g., under *Graham v. John Deere Co.* of Kansas City, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966)) regarding the level of skill in the art etc. Is the Office assuming an unarticulated high level of skill in the on-art rejections but an unarticulated low level of skill in the enablement rejection?

One of ordinary skill in the art would clearly be familiar with compressor design and control hardware/software. It is not as if this is an entirely new industry where everyone is just learning the ropes. Furthermore, it is not a low level of skill tinkering industry. The art involves corporate environments, often of major multi-national and conglomerate companies. Persons of ordinary skill in the art may have a wide variety of individual skills but also have access to the skills and resources of others in their companies. Thus, a person whose personal expertise is in compressor mechanical hardware may have a relatively high mechanical skill and a lower control skill but would still have access to colleagues with the reverse. Thus, one of ordinary skill would be a person who has substantial educational and/or practical experience in compressor engineering and control and/or clearly would have access to the resources of others yet more highly skilled in individual aspects of each of these areas.

Many existing manufacturers have compressor hardware and software which may, in view of the present disclosure, be easily reengineered/reconfigured by those skilled in the art.

Claim Rejections-35 U.S.C. 102

Claims 1, 2, 3, 17, and 24 were rejected under 35 U.S.C. 102(b) as being anticipated by Gunn et al. (US5820352).

Applicants maintain traversal of this existing ground of rejection for reasons of record.

Claim Rejections-35 U.S.C. 103

Claims 6, 7, 18, 19, 21-23, 26-28, and 30-32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gunn et al. in view of Kauffman et al. (US5209076).

Applicants maintain traversal of this existing ground of rejection for reasons of record.

Claims 4, 5, 20, and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gunn et al. in view of Allison et al. (US5772403).

Applicants maintain traversal of this existing ground of rejection for reasons of record.

Accordingly, Applicants submit that claims 1-42 are in condition for allowance. Reconsideration and further examination are requested. Please charge any fees or deficiency or credit any overpayment to our Deposit Account of record.

Respectfully submitted,

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